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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

PA4955US

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Application Number

10/625,726

Filed

July 24, 2003

First Named Inventor

Fumihiko Funazaki

Art Unit

2621

Examiner

Tat Chi Chio

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.



assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)



attorney or agent of record.

Registration number 46,060



attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Phillip E. Miller, Esq.

Typed or printed name

703-761-4100

Telephone number

April 15, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.



*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Serial No. 10/625,726
Docket No. PA4955US



1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Osamu Saito

Serial No.: 10/625,726 Group Art Unit: 2621
Filed: July 24, 2003 Examiner: Tat Chi Chio

For: METHOD AND APPARATUS FOR IMAGE REPRODUCTION, METHOD
AND APPARATUS FOR IMAGE RECORDING, AND PROGRAMS
THEREFOR

Honorable Commissioner of Patents
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Comes now the Appellant and respectfully requests that the Pre-Appeal Brief Conference Panel withdraw the rejection by the Examiner of claims 1-20 in the Office Action dated November 15, 2007, and the Advisory Action dated April 8, 2008. This request is filed concurrently with the filing of a Notice of Appeal.

Claims 6 and 11 stand rejected under 35 U.S.C. § 101 as allegedly directed to nonpatentable subject matter. Claims 6 and 11 have been amended according to the Examiner's helpful comments. Therefore, Appellant respectfully submits that this rejection should be withdrawn.

Claims 1, 2, 4-8, 10-11 and 15-20 stand rejected under 35 U.S.C. § 102(e) as being allegedly unpatentable over Kikuchi et al. (U. S. Pat. No. 6,553,180). **Claims 3 and 9** stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kikuchi. **Claim 12** stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kikuchi in view of Ando (U. S. Patent No. 7,286,746). **Claims 13 and 14** stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kikuchi in view of Terada (U. S. Patent Pub. No. 2003/0072561).

I. THE CLAIMED INVENTION

An exemplary aspect of the claimed invention (e.g., as defined by **claim 1**) is directed

to an image reproduction apparatus which includes reproduction control means for reproducing the first image data in the first image area in the case where the first image area has been selected and for reproducing the second image data in the second image area in the case where the second image area has been selected (Application at Figure 5; page 20, line 17 to page 22, line 21). This may allow the claimed invention to selectively reproduce first or second image data with ease from the recording medium (Application at page 7, lines 11-14).

Another exemplary aspect of the claimed invention (e.g., as recited in **claim 7**) is directed to an image recording apparatus which includes display control means for calculating a first data size regarding the first image data and a second data size regarding the second image data, and for displaying a screen including the first data size and the second data size on display means (Application at Figures 9 and 13; page 22, line 22-page 30, line 7). This may allow a user to record the first and second image data sets in the recording medium within the capacity of the recording medium (Application at page 30, lines 8-17).

II. THE ALLEGED PRIOR ART REFERENCES

A. Kikuchi

The Examiner alleges that Kikuchi teaches the claimed invention of claims 1, 2, 4-8, 10-11 and 15-20, and makes obvious the invention of claims 3 and 9.

Appellant submits, however, that Kikuchi does not teach or suggest an image reproduction apparatus which includes "*reproduction control means for reproducing the first image data in the first image area in the case where the first image area has been selected and for reproducing the second image data in the second image area in the case where the second image area has been selected*", as recited in claim 1 (Application at Figure 5; page 20, line 17 to page 22, line 21).

In fact, Kikuchi simply discloses that display unit 48 may display "DVD-RW" when a set disc 10 is a new DVD-RW disc (col. 40, lines 49-50), a recording mode and bit rate (col. 40, lines 58-59), a prompt for prompting user to exchange the disc (col. 40, lines 64-65), and title and chapter number (col. 42, lines 41-44).

Indeed, the Examiner surprisingly attempts to rely on Figure 40 and col. 45, lines 20-25 in Kikuchi to support his position. The Examiner is clearly incorrect.

In particular, the Examiner surprisingly asserts on page 2 of the Office Action that the

"first aspect ratio is equivalent to the first image area and the second aspect ratio is equivalent to the second image area since different aspect ratio produces different image size". This is completely unreasonable.

Indeed, the Examiner fails to understand that the "first image area" and "second image area" of the claimed invention are AREAS OF THE RECORDING MEDIUM which store image data. Moreover, the first and second image areas do not store just any old image data. Instead, the first image area OF THE RECORDING MEDIUM stores first image data for computer processing and the second image area OF THE RECORDING MEDIUM stores the second image data for digital video equipment. Thus, the Examiner's attempt to somehow equate an "aspect ratio" with the first and second image areas of the recording medium is completely unreasonable.

Second, the Examiner **repeatedly ignored the "selection screen" in claimed invention** (e.g., of claim 1) (e.g., see Application at Figures 6A and 6B). That is, nowhere in the Office Action does the Examiner allege that Kikuchi teaches the "selection screen" of the claimed invention.

On page 2 of the Advisory Action, the Examiner surprisingly refers to Figure 69 in Kikuchi as the "selection screen". This is completely unreasonable. Indeed, the "selection screen" of the claimed invention is *"for receiving a selection by a user of the first image area or the second image area"*. Figure 69 in Kikuchi, on the other hand, simply depicts "a view for explaining an example of a user menu formed by thumbnail pictures (A to E) corresponding to recorded contents" (Kikuchi at col. 7, lines 1-3). That is, **Figure 69 has nothing to do with selecting a first or second image area of the recording medium**.

Further, the Examiner equates the MPU in Figure 40 of Kikuchi with the "display control means" of the claimed invention. However, Figure 40 in Kikuchi simply illustrates a "block diagram" for an apparatus (DVD video recorder) (Kikuchi at col. 5, lines 32-37). Figure 40 illustrates that the MPU 30 is connected to a display unit 48. However, nowhere does Kikuchi teach or suggest that the display unit 48 displays THE SELECTION SCREEN of the claimed invention. Therefore, Kikuchi certainly does not teach or suggest a reproduction control means for reproducing the first image data in the first image area in the case where the first image area has been selected and for reproducing the second image data in the second image area in the case where the second image area has been selected, as in the

claimed invention.

Likewise Kikuchi does not teach or suggest an image recording apparatus which includes "*display control means for calculating a first data size regarding the first image data and a second data size regarding the second image data, and for displaying a screen comprising the first data size and the second data size on display means*", as recited, for example, in claim 7 (Application at Figures 9 and 13; page 22, line 22-page 30, line 7).

Indeed, the Examiner has repeatedly attempted to rely on col. 45, lines 20-25 in Kikuchi to support his position. Specifically, the Examiner alleges that "the 'Setup' key is used to set the screen size, which means the image size can be set with the 'Setup key'" (Office Action at page 5). However, the Examiner's allegations are completely unreasonable.

Indeed, the Examiner has repeatedly ignored the "screen" in the claimed invention (e.g., as recited in claim 7) (e.g., see Application at Figure 13). That is, nowhere in the Office Action does the Examiner allege that Kikuchi teaches the "screen" of the claimed invention.

In fact, the passage on which the Examiner relies simply refers to a size/aspect ratio of a screen. That is, Kikuchi teaches simply that a user can select an aspect ratio (e.g., 16:9 or 4:3) for displaying a video. However, this has nothing to do with the claimed invention. Indeed, nowhere does Kikuchi teach or suggest the "setup key" is used to calculate a first data size regarding the first image data and a second data size regarding the second image data. Indeed, the setup key is used to simply input information and has nothing to do with "calculating" anything.

Moreover, the setup key is simply a key and has no display function. Therefore, the setup key clearly does not display a screen including the first data size and the second data size on display means. Therefore, it is completely unreasonable to attempt to equate the setup key in Kikuchi with the display control means of the claimed invention.

Therefore, Appellant respectfully submits that this rejection should be withdrawn.

B. Ando and Terada

The Examiner alleges that Kikuchi would have been combined with Ando to form the invention of claim 12, and with Terada to form the invention of claims 13 and 14. Appellant submits, however, that these references would not have been combined.

Moreover, neither Kikuchi, nor Ando, nor Terada, nor any alleged combination

thereof teach or suggest an image reproduction apparatus which includes "*reproduction control means for reproducing the first image data in the first image area in the case where the first image area has been selected and for reproducing the second image data in the second image area in the case where the second image area has been selected*", as recited in claim 1 (Application at Figure 5; page 20, line 17 to page 22, line 21).

In fact, Ando simply discloses a medium for storing audio/image information and a system for managing the information. The Examiner attempts to rely on Figure 9 in Ando to support his position. However, Figure 9 is simply a block diagram illustrating a configuration of an apparatus for recording/reproducing information in/from an audio card (Ando at col. 7, lines 7-10).

Likewise, Terada simply discloses an image information recording medium, image information processor, and image information processing program. The Examiner attempts to rely on paragraph [0034] to support his position. However, this passage simply discloses an image data area 112 for recording repetitive images and an image data area 122 for recording a still image.

Nowhere does Ando, or Terada teach or suggest reproduction control means for reproducing the first image data in the first image area in the case where the first image area has been selected and for reproducing the second image data in the second image area in the case where the second image area has been selected. Therefore, neither Ando, nor Terada make up for the deficiencies in Kikuchi.

Therefore, Appellant respectfully submits that this rejection should be withdrawn.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date: 4/15/08


Respectfully Submitted,

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